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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,651	02/29/2000	MASANORI KAMATA	P18896	2074
7055	7590	11/12/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/514,651	KAMATA, MASANORI
	Examiner	Art Unit
	King Y. Poon	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 July 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 35-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 35-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 February 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The new title has been accepted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 41: Since the "character" is a value according to claim 40. It does not make sense to have a value that includes an action-input of a pause key.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 35-40, 42-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsunai (US 5,357,350).

Regarding claims 35, 44: Matsunai teaches an image recording apparatus (fig.

- 1) having a copy mode (STP1, fig. 4) and a facsimile mode (STP7, fig. 4), the image

recording apparatus comprising; a panel section (column 5, line 18) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of a number of copies (column 6, lines 66-67, column 7, lines 1-2) in the copy mode and a telephone number of a destination in the facsimile mode (column 7, lines 3-10); a display section (18e, fig. 2A, 2B, column 5, lines 19-21) which displays at least one of a screen for the copy mode and a screen for the facsimile mode, a display capacity of the screen in the copy mode being smaller than a display capacity of the screen in the facsimile mode (STP6, fig. 4); and a controller (PPC 2, column 6, lines 45-46) which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode (STP7 fig. 4), switches from the copy mode to the facsimile mode.

Regarding claim 36: Matsunai teaches wherein the display capacity of the screen, when the input numerical value corresponding to the number of copies is displayed, is smaller than the display capacity of screen, when the input numerical value the screen, when the input numerical value corresponding to the telephone number of the destination is displayed (STP6, fig. 4).

Regarding claim 37: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus comprising: a panel section (column 5, line 9) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of the a number of copies (STP 1, STP 5, fig. 4) in the copy mode and a telephone number (STP 8, fig. 4) of a destination in the facsimile mode, and which has a start key (18a, fig. 4) which

starts at least one of copying and facsimile transmission; and a controller (PPC 2, column 6, lines 45-46) which determines whether or not the numerical value input by the panel section is the numerical value corresponding to the number of copies when the copy mode is set, and which, when the numerical value input by the panel section is not the numerical value corresponding to the number copies, does not start copying, (according to fig. 4, the copy operation cannot be started even if start key is depressed when the number entered is not a copy number) even if the start key is actuated, the controller further being configured to wait (inherent properties when entering number one in a time, STP 5, fig. 4) for another input by the panel section when the controller does not start copying.

Regarding claim 38: Matsunai teaches according to claim wherein the controller determines that the input numerical value corresponds to the number of copies by using, as a threshold value (STP 6, fig. 4), a number of digits less than the number of digits utilized for the telephone number of the destination.

Regarding claim 39: Matsunai teaches wherein the another input by the panel section comprises an input of a reset key (clear, column 5, lines 15-20, return to initial state means reset).

Regarding claims 40, 46: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus comprising: a panel section (column 5, lines 9-10) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of the number of copies in the copy mode (before reaches 5, STP 6, fig. 4) and a telephone number of a

destination in the facsimile mode (after reaches 5, STP 6, fig. 4); and a controller (PPC 2, column 6, lines 45-46) which determines, when the copy mode is set, whether or not a numerical value input by the panel section includes a predetermined character (e.g., the character of 11111 or 23478, STP 6, fig. 4), and which switches from the copy mode to the facsimile mode when the numerical value input by the panel section includes the predetermined character.

Regarding claim 42: Matsunai teaches wherein when the controller switches from the copy mode to the facsimile mode, the numerical value input by the panel section is retained, the retained numerical value being utilized in the facsimile mode (STP 7, fig. 4).

Regarding claim 43: Matsunai teaches wherein the controller combines digits of a numerical value input by the panel section in the facsimile mode with digits of the retained numerical value (STP 7, fig. 4), after the controller switches from the copy mode to the facsimile mode, and calls the destination based on the telephone number including the retained numerical value (STP 12, fig. 4, in order to fax, the telephone (fax) number must be called).

Regarding claim 45: Matsunai teaches a method for controlling an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus having a start key (STP 3, STP 10, fig. 4) which starts at least one of copying and facsimile transmission, the method comprising: inputting a numerical value corresponding to at least one of a number of copies (smaller than 5, STP 6, fig. 4) in the copy mode and a telephone number (reaches 5, STP 6, fig. 4) of a

destination in the facsimile mode; determining whether or not the input numerical value is a numerical value corresponding to the number of copies when the copy mode is set (STP 6, fig. 4); inhibiting of the copying when the input numerical value is not the numerical value corresponding to the number of copies (according to fig. 4, the copy operation cannot be started even if start key is depressed when the number entered is not a copy number), even if the start key is actuated; and waiting for another input (inherent properties when entering number one in a time, STP 5, fig. 4) when copying is inhibited.

Response to Arguments

6. Applicant's arguments filed 3/31/2004 have been fully considered but they are not persuasive.

With respect to applicant's argument that, in Matsunai, the display capacity of the screen in the copy mode, is equal to the display capacity of the screen in the facsimile mode, has been considered.

In reply: According to fig. 4 of Matsunai, the display capacity of the screen (column 5, lines 19-21) in the copy mode cannot exceed 5 digits, while the display screen in the fax mode exceeds 5 digits.

With respect to applicant's argument that Matsunai does not teach and a controller which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy switches from the copy mode to the facsimile mode, has been considered.

In reply: Matsunai teaches a controller (PPC 2, column 6, lines 45-46) which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode (STP7 fig. 4), switches from the copy mode to the facsimile mode.

With respect to applicant's argument that the image forming apparatus of Matsunai does not maintains the copy mode but does not start copying, when the copy mode is set and when the value input by the panel section is not the value corresponding to the number of copies, has been considered.

In reply: Fig. 4, Matsunai, shows that STP 6 is checked during the copy mode and after the number that is not a copy number is being entered (N=5). After the number that is not a copy number is being entered in the copy mode, the program would prevent the copy operation being performed even if start key is on because the program is not at STP 3. Only the time the program is at STP 3 that a copy operation can be perform according to fig. 4.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892.

A handwritten signature in black ink, appearing to read "King Y. Poon".

11/5/04

KING Y. POON
PRIMARY EXAMINER